

Hand, Melanie (AU3761)

From: Alex Distell [adistell@hhpatent.com]
Sent: Tuesday, September 14, 2010 2:07 PM
To: Hand, Melanie (AU3761)
Subject: Serial No. 10/586,698 - Re: Japanese documents

Dear Examiner Hand,

Several weeks ago, we discussed the IDS submitted in the subject application on August 3, 2009. Following our conversation, you agreed to consider all of the references in that IDS, except for JP 62-97629 and JP 2-79919 (since no English abstracts or translations were provided). It appears that you inadvertently sent us copies of the IDS letter filed March 14, 2007 instead. I left you a message in this regard a couple weeks ago. I believe you tried to contact me last week; however, I was out of the office on vacation.

The message that was left for me indicated that you said you would consider all of the references in the August 3, 2009 IDS if I sent you English abstracts for JP 62-97629 and JP 2-79919.

I unsuccessfully searched the EPO and the Patent Abstracts of Japan (PAJ) search engine from the Japanese Patent Office for English abstracts of these references. I then consulted with a visiting Japanese client, who explained that English translations or abstracts of Japanese utility model applications (such as JP 62-97629 and JP 2-79919) are rarely published. According to the MPEP, we are required only to submit to the USPTO the documents available to us, including translations of any foreign documents. My understanding is that, when no such translations are available to the applicant, the Examiner is still supposed to "consider" and make of record the foreign references to the extent possible (even if that extent is extremely limited).

Given the above, would you agree to initial all of the foreign references in the August 3, 2009 IDS? If not, I will consider writing to our client to request that they obtain English translations of the references. In the latter case, I assume that it would be sufficient to email you the translations, without filing a new IDS.

I look forward to your prompt reply!

Best Regards,
Alex Distell

9/14/2010